

REMARKS

The Examiner indicated that the drawings filed with the application are acceptable for examination purposes only and that formal drawings will be required when the application is allowed. Applicants thank the Examiner for the acknowledgement of receipt and review of the informal drawings and have arranged for preparation of formal drawings, which formal drawings will be submitted with payment of the issue fee once the application is allowed.

The Examiner also indicated that the application as filed lacks an Abstract of the Disclosure. Applicants have drafted an Abstract that should be acceptable, a copy of which appears above, and another copy of which accompanies this response on a separate sheet. Applicants request that the Examiner ensure that the Abstract is properly entered into the file.

The Examiner rejected claims 1 and 4 under 35 U.S.C. § 102(e) as being anticipated by Bowers *et al.* (U.S. Patent No. 5,963,134). Applicants respectfully traverse this rejection and request its withdrawal.

A rejection under 35 U.S.C. § 102(e) is only proper when a reference discloses **all** elements of a rejected claim. While the Examiner states that Bowers *et al.* disclose a laser base station and a tag responsive to laser beams as recited, for example, in claim 1, in point of fact, Applicants see no mention of lasers anywhere in the disclosure of Bowers *et al.*, let alone the particular limitations of the rejected claims. Therefore, these claims and all claims dependent therefrom can be allowed since the rejection, based, as it is, on a reference that does not disclose **all** elements of the rejected claims, is improper and should be withdrawn.

The Examiner also rejected claims 2, 3, and 5-8 under 35 U.S.C. § 103(a) as being unpatentable over Bowers *et al.* (U.S. Patent No. 5,963,134) in view of Teitel *et al.* (for claim 2, U.S. Patent No. 5,812,257), Kibrick *et al.* (for claim 3, U.S. Patent No. 4,901,073), and Moran *et al.* (for claims 5-8, U.S. Patent No. 6,005,482). Applicants respectfully traverse this rejection and request its withdrawal inasmuch as Applicants respectfully submit that no *prima facie* case for obviousness has been established for any of the rejections of claims 2, 3, and 5-8.

Firstly, these rejections all use Bowers *et al.* as a base reference, which is deficient for the reasons stated above with respect to the rejection of claims 1 and 4 under 35 U.S.C. § 102(e). Specifically, Bowers *et al.* does not appear to make any mention of laser technology at all, let alone in the context of the limitations of the claims of the subject application. Secondly, while the Examiner alleges teachings of the various references, the Examiner has not pointed to any suggestions to combine the alleged teachings to form the claimed invention. The explanations the Examiner provides as to why one might combine the alleged teachings are convenient, but do not appear to be suggestions that come from the prior art. Rather, the only suggestion to combine would appear to come from Applicants' own disclosure, indicating that the Examiner is using impermissible hindsight reconstruction to reject the claims.

It is well established that the suggestion to combine features disclosed in references must come from the references themselves.¹ Thus, since the Examiner has not shown any such suggestion, no *prima facie* case of obviousness has been established, the rejection is improper and should be withdrawn, and the claims can be allowed. Applicants respectfully request such withdrawal of the rejection and allowance of all claims in the instant application.

¹ The Federal Circuit states that "The mere fact that the -prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), *citing In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). - "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." *Para-Ordnance Mfg. v. SGS Importers Int'l*, 73 F.3d at 1087, 37 USPQ2d at 1239, *citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13.

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

In view of the foregoing amendments and remarks the subject application is believed to be in condition for allowance. Therefore, further consideration and allowance of the subject application is requested. If the Examiner considers personal contact advantageous to the disposition of this case, please call Applicants' Attorney, David E. Henn at (716) 423-4299, Xerox Corporation, Rochester, New York 14644, or fax him at (716) 423-5240.

Respectfully submitted,



David E. Henn
Attorney for Applicants
Registration No. 37,546

DEH/gmm

VERSION WITH MARKINGS TO SHOW CHANGES MADE

ABSTRACT OF THE DISCLOSURE

A tracking/identification system uses tags reactive to incident laser beams to track the tags. Laser beams emanate from a laser base station to strike tags, which reflect the beams back to the base station. The system receives input from the base station and stores position and informational content of tags. The system can determine tag angular position with respect to the base station. Multiple base stations can be employed to determine absolute position of tags. The tags can be passive, can have internal power supplies to power data broadcast elements. A mix of powered and passive tags can be used.